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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,183	12/01/2003	Hideyuki Nakamura	Q78725	1328

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EXAMINER

SCHILLING, RICHARD L

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/724,183

Applicant(s)

NAKAMURA, HIDEYUKI

Examiner

Richard L Schilling

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12-01-03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) The invention was described in (1) an application for patent, published under Section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 102(a) and (e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Miyake et al. '197. Miyake et al. (see particularly paragraphs 11, 148-153, 160-162; Example 1) disclose thermal transfer elements with light to heat conversion layers preferably comprising polyamide-imide resins and cyanine infrared absorbing dyes. Example 1 uses infrared absorbing dye NK-2014 which is the same as dye B in applicant's working Example 2. The same dye would inherently and obviously have the same water content. The light to heat conversion layers in Miyake et al. are dried at the same temperature and time as in applicant's working Examples and is about the same thickness as the thickness in applicant's working Example 2 so that any water removal would be about the same. The Examples in applicant's specification use different infrared absorbing dyes for different water contents and not the same dye with different water contents. If Miyake et al. do not anticipate the instant claims, then it would at least be obvious to one skilled in the art to use the infrared absorbing dyes of working Example 1 of Miyake et al. with the preferred polyamide-imide binders of Miyake et al. instead of the polyimide of Example 1 in Miyake et al.

2. Claims 1-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Suzuki et al. '579 and

Arai et al. Suzuki et al. (see particularly paragraphs 58, 149-156; Example 1) discloses heat transfer elements comprising light to heat conversion layers containing polyimide or polyamide binders and infrared absorbing cyanine dyes. Example 1 uses cyanine dye NK-2014 which is the same dye as used in applicant's working Example 2 as dye B. The same dye would inherently and obviously have the same water content. Arai et al. (see particularly column 5, lines 36-51; column 8, line 45 - column 9, line 23) discloses photothermal conversion layers for converting laser light into heat to heat a heat sensitive recording layer. Arai et al. teaches that the binders for the light to heat conversion layers may be polyimide, polyamide or polyamide-imide for binding infrared absorbing dyes including cyanine dyes as in Suzuki et al. Therefore, it would be obvious to one skilled in the art to substitute the polyimide or polyamide binders of the light to heat conversion layers in Suzuki with the disclosed functionally equivalent polyamide-imide binders of Arai et al.

3. Maejima et al. is cited of interest in the art as disclosing light to heat conversion layers comprising water soluble infrared absorbing dyes. Shimomura et al. and Nakamura et al. are cited of interest in the art as disclosing light to heat conversion layers containing cyanine dyes the same as dye B in applicant's working Examples. The prior art submitted by

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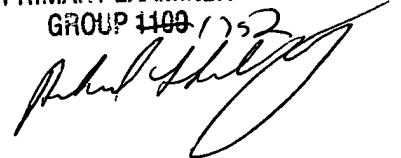
applicants has been considered.

4. Any inquiry concerning this communication should be directed to Mr. Schilling at telephone number (571) 272-1335.

RLSchilling:cdc

December 28, 2004

RICHARD L. SCHILLING
PRIMARY EXAMINER
GROUP 1100/1752

A handwritten signature in black ink, appearing to read 'Richard L. Schilling', is written over the printed name and title.